

Appl. No. 09/976,553
Amdt. dated January 28, 2004
Response to Office Action Mailed December 17, 2003

REMARKS

Applicants wish to thank the Examiner for taking the time to point out the particular portions of the prior art relied on in the Office Action for the present application. Claims 1-44 remain in this application.

Claims 1-10, 12-22, 24-29, 31-36, 38-41, 43, and 44 are rejected as being unpatentable over Marocco '857 in view of Stevens. Claims 11, 23, 30, 37, and 42 are rejected as being unpatentable over Marocco '857 in view of Stevens, and in further view of Marocco '388. Claim 5 is rejected as being unpatentable over Marocco '857 in view of Stevens, and further in view of Wang '557. Claims 10, 22, 29, 34, and 43 are rejected as being unpatentable over Marocco '857 in view of Stevens, and further in view of Wang '172.

For the reasons discussed, the rejections are traversed. It is Applicants' belief that for the reasons discussed the rejections should be withdrawn and the claims passed to allowance.

The Patent Office bears the initial burden of factually supporting and establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); MPEP §2142. Applicants respectfully submit that no *prima facie* case of obviousness has been made, and therefore the rejections should be withdrawn. *See, In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).


To establish a *prima facie* case of obviousness, it is incumbent on the Patent Office to demonstrate at least some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

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combine reference teachings. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). The Patent Office must also demonstrate that the prior art reference (or references when combined) teach or suggest all the claim limitations. *Id.* Applicants submit that the Office Action fails to satisfy these criteria, and therefore has not established a *prima facie* case of obviousness. The cited prior art does not disclose all elements of the claimed invention, and there is no evidence of a suggestion or teaching to combine the references. As such, rejection of the aforementioned claims based on obviousness should be withdrawn.

A. The Combination Of The Cited Prior Art Does Not Teach The Present Invention

Each of the combinations relied upon in the §103 rejections is based primarily on the combination of Marocco '857 with the Stevens patent. Applicants respectfully submit that no *prima facie* case of obviousness has been made for any of the combinations because the combination of Marocco '857 with Stevens fails to disclose an element found in all the claims.

 It is stated in the Office Action that Marocco '857 discloses, among other things, "a manually operated drive mechanism (Fig. 19, 262, 264) to cause the plate to cut the head rail and cause the blade assembly to cut the bottom rail and the blind slats concurrently (col. 11, lines. 24-47)." This is incorrect. Marocco '857 does not disclose any embodiment wherein a drive assembly causes a plate to move and cut the head rail while also causing the blade assembly to move and cut the bottom rail and blind slats. In other words, Marocco '857 does not teach any embodiment where even a portion of the cutting operation of the head rail is at the same time as the cutting operation of the blind slats. Instead, Marocco '857 only discloses embodiments where

Yes it does,
see Marocco
col. 11
line
32-34
41-47

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the movement of the head rail cutter and movement of the blind slats cutter are independent such that cutting of the head rail and the cutting of the bottom rail and blind slats are done at separate times. The stated reason Marocco '857 separates the cutting operation is to reduce loading and create a mechanical advantage in order to cut manually. *See e.g.*, col. 12, ll. 30-49.

With the first embodiment, Marocco '857 expressly states that "[t]he trimming of the blind slats S is carried out in this embodiment as a separate function from the trimming of the headrail and the bottom rail." (col. 7, ll. 14-16).

Similarly, the embodiment shown in FIG. 13 also illustrates that the cutting of the blind slats is done after the cutting of the head rail.

A headrail shear blade 154 is provided on one side of the shear member 148 and a bottom rail shear blade 156 is provided on the other side registering with the respective headrail and bottom rail openings 142 and 144. Between the two shear blades there is a rectangular clearance space 158 in shear member 148, the purposes of which is to fit around either side of the blind slat portion S, extending through the main body 140. It will also be seen that in this embodiment, by the operation of the cam 152 the entire shear member 148 will be driven downwardly. **This will cause the two shear blades 154 and 156 to cut the headrail and the bottom rail. After this, the shear member 148 will be raised upwardly, and cutting of the blind slats S can then proceed in the manner already described above.** (Col. 9, ll. 19-32)(emphasis supplied).

Thus, as shown, the head rail cutter is not moved along with the blind slats cutter. Instead, the head rail is cut in a separate operation.

Other embodiments in Marocco '857 even specify that the drive mechanism for cutting of the head rail is controlled with a separate lever from the drive mechanism for cutting the blind slats. For example, the embodiment in FIG. 15 states that "the invention may also be carried out

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using two separate manual controls for cutting various of the blind components separately by separate manual operations." (Col. 9, ll. 39-42).

A cutting blade 192, for cutting the blind slats, would be operated by means of rods 194 and 196, and wheel 198 and handle 200. **In this way, the cutting of the headrail and the bottom rail is achieved by one manual operation, and the cutting of the blind slats is achieved by another manual operation.** (Col. 9, l. 63 - col. 10, l. 4) (emphasis supplied).

Similarly, in the embodiment relied upon in the Office Action, it is also made clear that a drive mechanism does not operate to cut the head rail, bottom rail and blind slats. Instead, the head rail is cut in one operation, and the blind slats and bottom rail are cut separately.

In order to reduce the loading on the manual cutter mechanism, in this embodiment of the invention, there are two manual mechanisms. ... **The first lever 316 is then operated to cut the bottom rail and the bundles of blind slats by moving the block 304 horizontally. When that has been completed, then the second lever 326 is operated, so as to move the diagonal block 306 thereby cutting the headrail.** (Col. 12, ll. 30-49) (emphasis supplied).

Thus, none of the embodiments in Marocco '857 discloses a drive mechanism that cuts the head rail and blind slats as in the present invention.

Applicants note that there is one embodiment in Marocco '857 where a single drive moves the cutters for blind slats and the head rail with a single movement stroke. In this embodiment too, however, the cutting of the head rail is done separately from the cutting of the blind slats.

As also illustrated in FIGS. 8, and 9 and 10, it is possible to provide for operation of the blind slat cutting blade, in synchronism with the operation of the die plate for cutting the headrail and bottom rail. This may be achieved, by means of connecting the drive shaft 74 driving the blade assembly, by means of a cross bolt 120, to a lost motion linkage 122. Lost motion linkage 122 has a slotted opening 124 to receive bolt 120, thereby allowing the linkage 122 to move a predetermined distance, before it engages bolt 120. ... In this way when the arm 54 is swung

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toward the operator to rotate hub 52, so as to cut the headrail and bottom rail, a predetermined distance, swinging of the arm 54 a further distance will cause movement of the bolt 120, and connecting rod 74 thereby causing movement of the blade assembly for shearing the ends of the blind slats. (Col. 8, ll. 42-59).

In other words, the lost motion linkage enables only the headrail cutter or the blind slats cutter to be moved at a particular time. Thus, the two cutters are not moving such that the head rail is cut while the blind slats are also being cut.

It should be noted that the Marocco '857 patent was the subject of litigation wherein the district court held, and the Federal Circuit affirmed, that Marocco '857 did not disclose concurrent cutting as found in the present invention. The case is *Springs Window Fashions LP v. Novo Indus., LP*, 323 F.3d 989 (Fed. Cir. 2003), and the opinion is attached.

During the litigation, the alleged infringers argued and the district court held that the claims of Marocco '857 were limited such that drive mechanism or mechanisms must be capable of moving independently such that the cutting of the head rail and the cutting blind slats are done separately. *Id.* at 992. The district court further found that the specification of Marocco '857 confirmed that the inventor intended to limit the invention to detached and independently moveable cutters. *Id.* at 992-993. The judgment of the district court was affirmed. *Id.* at 1000.

Accordingly, none of the combinations of prior art set forth in the Office Action teach cutting as set forth in claims 1-44. Therefore, no *prima facie* case of obviousness has been made and the rejections should be withdrawn with respect to all of claims 1-44.

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B. There Is No Teaching Or Suggestion In Cited Art To Combine References

A second requirement to establish a *prima facie* case of obviousness is that the Patent Office must provide evidence of "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 at 1074, 5 USPQ2d at 1598; *see also* MPEP §2143.01. Rather than general desires, the evidence of a teaching, motivation, or suggestion to select and combine the references must be specific. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *see also, In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.").

Applicants respectfully submit that the Office Action provides no evidence of any sustainable motivation or suggestion to combine the cited prior art references. With the combination of Marocco '857 with Stevens, the only cited motivation to combine is "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Marocco '857 with a rotatable plate with a head rail aperture and configured to cut the head rail as taught by Stevens to simplify the mechanism for cutting the head rail." (p. 2-3).

There is, however, no specific teaching in Stevens that rotatable cutting is in any way simpler than linear cutting. Applicants respectfully submit that the opposite is true. When an

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assembled Venetian blind is to be cut, it is laid on a support such that the head rail, bottom rail and slats are on a shared plane. Absent the desire recognized in the present application to reduce the load on cutter and to achieve a mechanical advantage while maintaining the ability to concurrently cut the various blind components, there would be no reason to cut any of these components in a rotational manner.

While Stevens teaches that a mechanical advantage can be obtained with rotational cutting, Marocco '857 actually teaches away from such a cutter and provides no reason to combine a rotational cutter with the blind cutting apparatus disclosed therein. "[R]eferences that teach away cannot serve to create a prima facie case of obviousness." *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1353, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001). Rotational cutters are, as evidenced by the 1874 Stevens patent, old in the art. Nonetheless, Marocco '857 eschews using such a technique to obtain a mechanical advantage. Instead, Marocco '857 takes the path of obtaining a mechanical advantage through separation of the cutting of the head rail from the cutting of the blind slats. Therefore, Marocco '857 teaches away from concurrent cutting of the head rail, bottom rail and blind slats, as well as the use of a rotational cutter. This too detracts from any motivation or suggestion to combine the cited art.

Applicants further respectfully submit that the unsupported statements in the Office Action as to by what a person of ordinary skill in the art would have been motivated is improper.

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. ... [A]ny facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner

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which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. MPEP §2144.03 (citations omitted).

No evidence is provided in the Office Action to support the assertion that the motivation to combine would have been obvious to one of ordinary skill.

Instead, the Office Action uses the claimed invention and picks individual elements from the prior art to fit the claimed elements. This is decidedly improper. "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600. Whether the various parts disclosed in the prior art could possibly be combined in the same manner as claimed and whether the resulting combination would be simpler misses the point. The prior art must suggest such a combination without the benefit of the claimed invention as a roadmap. The Office Action sets forth no evidence of this suggestion.

At best, the stated motivation to "simplify the mechanism for cutting" evidences only a desire to make machines less complicated. The general desire to simplify machines, however, cannot amount to the required motivation or suggestion. *See e.g., In re Deuel*, 51 F.3d 1552, 1559, 34 USPQ2d 1210, 1216 (Fed. Cir. 1995) ("A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out.").

Accordingly, the rejections should be withdrawn for the reason that the prior art fails to provide a suggestion or teaching to combine the references.

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D. Conclusion

For the reasons stated above, Applicants traverse the rejections and request withdrawal thereof. Applicants respectfully submit that the application is in condition for allowance and request same.

Respectfully submitted,

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